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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,142	08/21/2001	Anthony Craig Shurman	YOSHA-2 (temp.)	8865

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BAKER & MCKENZIE  
805 THIRD AVENUE  
NEW YORK, NY 10022

EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/935,142

Applicant(s)

SHURMAN, ANTHONY CRAIG

Examiner

Luan K Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-17,19-32,34-39,41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,19-32,34-39,41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,8.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 7.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

<b>Interview Summary</b>	Application No.	Applicant(s)	
	09/935,142	SHURMAN, ANTHONY CRAIG	
	Examiner	Art Unit	
	Luan K Bui	3728	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Luan K Bui. (3) James Jacobs.  
 (2) Frank Gasparo. LAB (4) \_\_\_\_\_

Date of Interview: 3/5/03

Type: a) ☒ Telephonic b) ☐ Video Conference  
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
 If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: of record.

Identification of prior art discussed: as applied.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant was requested for a telephone interview after filing the amendment, the Examiner was indicated that the interview will be granted if Applicant is agreed not to file a supplemental amendment after the interview unless the agreement was reached. Applicant presented arguments about differences between the claimed invention and the applied prior art, which arguments were taken under advisement.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
 Examiner's signature, if required

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-8, 10-13, 19-21, 23, 26-28, 30, 34-36 and 38 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases “the cigarette package is ...” in claims 4 and 11, “so that the flip top ...” in claim 5, “the confectionary items are ...” in claims 7, 8, 19-21, 26-28 and 34-36, “the wrapper is ...” in claims 10, 23, 30 and 38, “the height of the cigarette package ...” in claim 12, “the width of the cigarette package is ...” in claim 13 define the dispensing container in reference to the cigarette package or the confectionary items which is undefined and has not been positively claimed rendering the claims vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-8, 10-13, 16, 17, 19-21, 23-28, 30-32, 34-36, 38, 39, 41, 43 and 44 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Moon, 3<sup>rd</sup> (2,727,547; hereinafter Moon). Moon discloses a dispensing container comprising a body (10) having a top portion

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(upper part of the container) and a bottom portion (lower part of the container) for storing medical supplies or other material are sometimes carried in the pockets or elsewhere on the persons of individuals, and a door (11) connected to the top portion of the body. The bottom portion of the body having a tapered edge (Figure 4). The container of Moon is inherently capable of receiving the confectionary items as claimed and the container of Moon is inherently capable of inserting between the wrapper and the cigarette package.

5. Claims 1, 3-8, 10-13, 16, 17, 19-21, 23-28, 30-32, 34-36, 38, 39, 41, 43 and 44 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Cillario (4,538,731; hereinafter Cillario'731). Cillario'731 discloses a dispensing container (1) comprising a body (3, 4, 5, 9, 10) having a top portion (upper part of the container) and a bottom portion (lower part of the container) for storing confectionary items, and a door (15) connected to the top portion of the body. The bottom portion of the body having a tapered edge (Figures 1 and 3). The container of Cillario'731 is inherently capable of inserting between the wrapper and the cigarette package.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9, 14, 15, 22, 29 and 37 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cillario (4,538,731; hereinafter Cillario'731) in view of Ciaccio (4,804,113;

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hereinafter Ciaccio'113). Cillario'731 discloses a dispensing container (1) comprising a body (3, 4, 5, 9, 10) having a top portion (upper part of the container) and a bottom portion (lower part of the container) for storing confectionary items, and a door (15) connected to the top portion of the body. Cillario'731 also discloses the other claimed limitations except for a second being located on a second side of the body. Ciaccio'113 shows a container (12) comprising a body (16) having two chambers and two doors (30, 32) with each door located on each chamber for dispensing an item in that chamber (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Ciaccio'113 to modify the dispensing container of Cillario'731 so it includes a first door located on a first side of a first chamber and a second door located on a second side of a second chamber to facilitated dispensing the confectionary items from each chamber. As to claims 9, 22, 29 and 37, Cillario'731 fails to diclose the body and the door are made of a translucent material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the body and the door of Cillario'731 so the body and the door are made from a translucent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### ***Response to Arguments***

Applicant's arguments with respect to all pending claims have been considered but are deemed to be moot in view of the new grounds of rejection.

In response to applicant's arguments regarding the phrases “operable for inserting the body between the wrapper and the cigarette package” or “operable to dispense the confectionary items” and others, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3580 or (703) 872-9302 for Formal papers and (703) 872-9303 for After Final communications.

lkb  
March 14, 2003



Luan K. Bui  
Primary Examiner